

IV. Remarks.

The Examiner entered the following rejections in the office action.

1. Claim 1-5 are rejected under 35 USC 103(a) as being unpatentable over Serkh (5,938,552) in view of Henderson (4,886,483).

A rejection based on 35 U.S.C. §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In Re Raynes, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed.Cir.1993). In the context of an analysis under §103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Dreck Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed.Cir.1999). This is because "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for

piecing together the prior art to defeat patentability." Id. Accordingly, to establish a rejection under 35 U.S.C. §103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Serkh teaches a tensioner with a base, a pivot-arm that oscillates about a pivot secured to the base, a pulley attached to the pivot-arm, a compression spring with a first end operatively connected to the pivot-arm and a second end operatively connected to a shoe that presses a convex surface of the shoe against a concave arcuate surface of the pivot-arm, to the shoe held in place against a protuberance secured to the base by a balance of forces.

Henderson teaches a tensioner for a power transmission belt that is adapted to be operated in an endless path and a method of making the same are provided, the tensioner having a frictional dampening unit operatively associated with the support unit and the belt engaging unit thereof to dampen the movement of the belt engaging unit relative to the support unit, the dampening unit comprising a pair of frictionally engaging first and second parts with the first part comprising an annular pad of friction material that is coaxially disposed and axially movable on a shaft relative to the second part, and a spring urging the first part against the second part with a certain spring force, the tensioner having an antifriction annular disc-like member disposed on the shaft between the first spring and one of the support unit and the belt engaging unit, the first part of the dampening unit having a guide thereon, the one of the support unit and the belt engaging unit having an opening therein that receives the guide therein to guide axial movement of the first part, the tensioner having a bearing disposed in the opening and receiving the guide therein, the antifriction disc-like member carrying the bearing on one side thereof.

As to claim 1, the references do not teach all of the claimed limitations. As to the adjustment portion extending from the arm, Henderson teaches:

"When the tensioner 22 of this invention has been mounted to the engine 20, the torsion spring 87 is so wound up that it is tending to urge the pulley 80 in a counterclockwise direction against the belt 21 as illustrated in FIG. 1. The adjustment of the pulley 80 onto the belt 21 is facilitated by a suitable tool being inserted into a rectangular opening

127 formed in the arm 70 so that the arm 70 can be rotated to place the pulley 80 onto the belt 21 in opposition to the force of the torsion spring 87."

Henderson, col. 7, lines 41-50. (emphasis added).

In paragraph 2 of the office action the Examiner argues that "Henderson discloses a tensioner comprising an arm (38) having an adjustment portion (75) extending from the arm, wherein the extended portion comprising a tool receiving portion (127)". The Examiner also identifies support means (36) as being analogous to the claimed base.

The Applicant agrees with the substance of this argument, however, the described arrangement of Henderson is inapposite to the limitation in the claimed invention. The claim limitation is: "an adjustment portion extending from the base comprising a tool receiving portion". Namely, the claim limitation is directed to a tool receiving portion extending from the base. On the other hand, Henderson only teaches a tool receiving portion extending from the pivot arm. The features are not analogous.

In the claimed invention base 30 is rotated by use of a tool (T) in order to generate a spring force in pivot arm 32. Base 30 is pivoted by tool (T) to compress spring 36 against pivot arm 32. See application page 7, lines 8-25 and lines 15-16. In other words, movement of the base with a tool in the claimed invention is intended to apply a spring force to the pivot arm during belt tension adjustment.

On the other hand, Henderson teaches use of a tool to cause rotation of the pivot arm in a direction counter to the force exerted by the torsion spring, see quote from Henderson above. Namely, the pivot arm of Henderson must be "backed off" by use of a tool in order to allow installation of the belt. However, the base in Henderson is not adjustable nor does it comprise an adjustment portion comprising a tool receiving portion as claimed. Hence, the combination of references does not teach all of the claimed limitations, nor is there incentive to combine the references since neither teaches a tool receiving portion extending from the base.

Applicant requests the rejection be withdrawn.

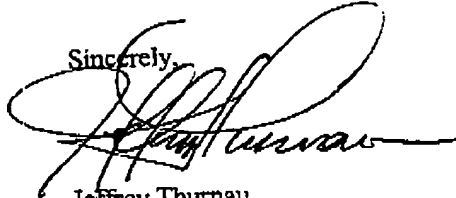
Claims 2-5 depend directly or ultimately from claim 1.

V. Fees.

Any fees payable for this argument may be deducted from deposit account 07-0475 in the name of The Gates Corporation.

Thank you for your attention to this case. If any questions arise, please call at the number below.

Sincerely,



Jeffrey Thurnau
Attorney for Applicant
Reg. No. 42,183
303-744-4743

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